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09/589,647	06/07/2000	Joe McCollum	23200 EH-001	8728

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/589,647

Applicant(s)

MCCOLLUM ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 23 May 2003. Claims 1-26 remain pending. Claims 21-26 have been newly added.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-10, 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 in view of Edelson et al, U.S. Patent Number 5, 737, 539 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 1-2, 4-10, 12-20 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 3, pages 2-8), and incorporated herein.

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4. Claims 3, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 and Edelson et al, U.S. Patent Number 5, 737, 539, as applied to claims 1 and 2 above, and further in view of Coli et al, U.S. Patent Number 6, 018, 713 for substantially the same reasons given in the previous Office Action (paper number 6). Further reasons appear hereinbelow.

(A) Claims 3, 11 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 6, section 4, pages 8-9) and incorporated herein.

5. Newly added claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt, U.S. Patent Number 5, 659, 741 in view of Edelson et al, U.S. Patent Number 5, 737, 539.

(A) As per newly added claims 21, 23, 25, Eberhardt and Edelson disclose a method and system as analyzed and disclosed in the rejections of claims 1, 2, and 16 of the prior Office Action (paper number 6) and above in the preceding sections of the present Office Action, wherein said cover letter is a paper letter or hard copy or a printout (Edelson; column 9, lines 29-35, column 15, lines 25-27, column 17, lines 42-55).

(B) As per newly added claims 22, 24, 26, Eberhardt and Edelson disclose a method and system as analyzed and disclosed in the rejections of claims 1, 2, and 16 of the prior Office Action (paper number 6) and above in the preceding sections of the present Office Action,

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wherein said patient authorization letter is a paper letter or hard copy or a printout (Edelson; column 9, lines 29-35, column 15, lines 25-27, column 17, lines 42-55).

The motivations to combine Eberhardt and Edelson are as discussed in the prior Office Action (paper number 6), and incorporated herein.

### ***Response to Arguments***

6. Applicant's arguments filed 23 May 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 23 May 2003.

(A) At pages 3-4 of the 23 May 2003 response, Applicant argues that the limitations claimed in originally filed Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 23 May 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Eberhardt, Edelson, and Coli based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein. In particular, Examiner notes that sending by a requestor a cover letter and sending a patient authorization letter to a processing center for completing the order are

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taught by the cited references. Furthermore, Examiner respectfully submits that the use of the clarifying words, "or authorization" in describing Applicant's cover letter was not intended "to read an additional (optional) limitation into the claims" but rather to point to Applicant's usage of the term in Applicant's own specification (see, for example, Figure 6, Item 600, page 3, lines 17-18, page 4, lines 22-23, page 11, lines 9-11). In addition, Examiner respectfully submits that the use of the clarifying words, "or electronic release" in describing Applicant's "patient authorization letter" was not intended "to read an additional (optional) limitation into the claims" but rather to point to Applicant's usage of the term in Applicant's own specification. Consider, for example, page 3, lines 14-18 of Applicant's specification, in which the Electronic Health Information site on the Internet provides an "authorization for release" cover letter.

(B) At pages 4-5 of the 23 May 2003 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eberhardt's system and method of storing and accessing medical record information (Eberhardt; Abstract) to include Edelson's invention, which provides to the requestor a cover letter or authorization having an identifier, the identifier having order information; sending, by the requestor, the cover letter along with a patient authorization letter to a processing center, for completing the order; requesting, by the processing center, to a shipping location to ship the patient record or document to a destination location (Edelson; column 9, lines 23-28, column 9, line 66 to column 10, line 14, column 15, lines 25-27, column 16, lines 10-24, column 17, lines 5-62, column 31, lines 55-63) with the motivation of making integrated patient-specific information readily available to medical prescribing professionals, to utilize medical information which is widely distributed geographically, and to enable such access in the light of proprietary, liability and patient confidentiality concerns (Edelson; column 2, lines 8-15).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make

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modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.



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In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

(C) At page 5 of the 23 May 2003 response, Applicant argues that the newly added features in the 23 May 2003 amendment are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 23 May 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Eberhardt, Edelson, and Coli, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein. In particular, Examiner notes that although there is a distinction

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between an electronic document such as a cover letter or patient authorization and a paper document, the cited references, when properly considered together as a whole, teach or make obvious both situations. Further, Examiner respectfully notes that the American Heritage® Dictionary of the English Language, Fourth Edition defines cover letter as follows: "cover letter: NOUN: A letter sent with other documents to explain more fully or provide more information. Also called covering letter." URL: <<http://www.bartleby.com/61/46/C0704600.html>>.As such, the proper combination of the above teachings, for the reasons and motivations given above, apply to both types of documents.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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**8. Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:**

(703) 305-7687.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.


Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

  
Natalie A. Pass

July 30, 2003

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3000